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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,714

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Yuanping Chen

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OFFICE OF COMMAND COUNSEL,
U.S. ARMY MATERIEL COMMAND
ATTN: AMCCC-B-IP
9301 CHAPEK ROAD
FORT BELVOIR, VA 22060-5527

EXAMINER

QUACH, TUAN N

ART UNIT

PAPER NUMBER

.2826

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/807,714	CHEN ET AL.	
	Examiner	Art Unit	
	Tuan Quach	2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/28/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 35-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Tuan Quach
Primary Examiner

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of claims 1-34 in the reply filed on April 28, 2006 is acknowledged. The traversal is on the ground(s) that if the structure of claim 1 is patentable then its use in a radiation detector is ipso facto patentable as well and applicant needs not to amend claim 56 to include the limitation of claim 1. This is not found persuasive because this is conditioned on claim 1 being unpatentable which applicant has not shown to be necessarily the case; the validity remains insofar as claim 56 reciting all the limitations regarding the film in question which is not necessarily the case here. Furthermore, the structure in claim 56 requires additional layer or structure not evident in claim 1 and recites the layer in question not the same as those in claim 1; conversely the structure in claim 1 can be employed in structures other than those claimed in claim 56; additionally, applicant has not admitted on record that the species correspond to obvious variants. Applicant further has not shown that the search would not require serious burden argument; it appears that the search for both species would impose serious burden regarding the particular device in question in a different classification and the multitude or various elements or structures.

The requirement is still deemed proper and is therefore made FINAL.

Applicant is requested to provide a copy of the Chen et al. article cited on its IDS; the copy thereof has not been received and was not considered.

Claims 20, 27, 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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"and z is greater . . ." in claim 28 is erroneous since the film in question is $\text{CdSe}_x\text{Te}_{1-x}$. The antecedent basis for "the cadmium chalcogenide" in claim 20 appears to correspond to claim 19, not claim 14. (not quite clear here?) in claim 27 is unclear or erroneous.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

For convenient referencing, et al. is omitted.

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rajavel in view of Han and Mitra.

Re claims 1, 2, 21, Rajavel 5,742,089 teaches multilayer structure comprising a silicon based substrate 14, epitaxial layer 18 including II-VI semiconductor material including combination of two binary alloys such as CdSe/ZnTe but lacks the specific recitation regarding the composition, e.g., of $\text{Cd}_{1-z}\text{Zn}_z\text{Se}_x\text{Te}_{1-x}$. The provision of overlayer 20, e.g., HgCdTe is also taught. See column 3 line 45 to column 8 line 65.

Han 7,056,471 B1 teaches homogeneous II-VI quarternary alloys $\text{M}_{1-x}\text{M}_2\text{x}\text{A}_y\text{B}_{1-y}$ having improved characteristics and easy to produce. including the specific recitation of $\text{Zn}_{1-x}\text{Cd}_x\text{Se}_y\text{Te}_{1-y}$. The selection of the indices to be between zero and 1 is also taught. See the abstract, column 1 line 5 et seq., column 3 line 60 et seq., column 4 line 4 to column 9 line 65.

It would have been obvious to one skilled in the art in practicing the above invention to have selected the quarternary compounds as claimed since such quarternary compounds are conventional, advantageous, and easy to produce as evidenced by Han. It would have been obvious and would have been within the purview of one skilled in the art to have selected the appropriate values of the indices x and z, given the teachings of Han evidencing the overlapping range. Additionally, such variation would have been further obvious and advantageous as evidenced by Mitra, 6,208,005, column 5 line 60-65 wherein the variation of the alloy composition would have been conventional and obvious to obtain the desired film characteristics, e.g., desired bandgap. Re claims 3, 16, 28, the use of z being zero corresponds to the omission or minimization of Zn, such would have been obvious when x in Han is maximized and as shown in Rajavel, column 4 lines 14-15 when CdSe and CdTe are employed as the binary compounds thus obviating Zn. It is well settled that In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped.); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium

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Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) "[A] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a prima facie case of obviousness." In re Peterson, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). A range can be disclosed in multiple prior art references instead of in a single prior art reference depending on the specific facts of the case. Iron Grip Barbell Co., Inc. v. USA Sports, Inc., 392 F.3d 1317, 1322, 73 USPQ2d 1225, 1228 (Fed. Cir. 2004). The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

Re claim 4, the use of an overlayer of CdX' corresponds to passivating layer 16 including Cd and Se or Te as shown in Rajavel, column 4 lines 1-5. Re claim 6, the use of single crystal silicon substrate is well known in the art and is encompassed in Rajavel and as such would have been obvious. Re claims 6-10, 15-18, 22, 26, 29, 33, such selection would have been obvious and would have been encompassed or overlapped in the range taught in Han as delineated above and in view of the optimization as suggested by Mitra above; it is well settled that in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Re claims 11-12, 23, 24, 30, and claims depending therefrom, concerning the surface defect density, the Office

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is not equipped to measure the surface defect density in question, such would be inherent in or unpatentable over the prior art above, absent evidence to the contrary as the same layer or substantially similar material is obtained; it is well settled that once the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. Re claims 13-14, 19, 20, 24, 25, 31, 32, and claims depending therefrom, the recitation of the overlayer such as cadmium chalcogenide $\text{Hg}_{1-y}\text{Cd}_y\text{Te}$ overlayer is also taught in Rajavel supra, layer 20/22, column 4 lines 25-58. Re claims 27 and 34, these correspond to product-by-process feature and are deemed to be unpatentable over the prior art; it is well settled that for a product-by-process it is the patentability of the product which must be determined. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Alternatively, such source for deposition is well known in the art and as such would have been obvious.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hamilton Jr 5,449,927 and Kazandjian 7,067,008 B2 are made of record.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Tuan Quach whose telephone number is 571-272-1717. The examiner can normally be reached on M-F from 8:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Nathan Flynn, can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tuan Quach
Primary Examiner